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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,887	11/26/2003	Thomas M. Laney	87430CPK	1673

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EXAMINER	
BUTLER, PATRICK	

ART UNIT	PAPER NUMBER
1732	

MAIL DATE	DELIVERY MODE
10/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/722,887	LANEY ET AL.	
	Examiner	Art Unit	
	Patrick Butler	1732	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on *05 September 2007*. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): none. However, the objection to the Specification is withdrawn.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *19,21-26,29,30 and 40*.
   Claim(s) withdrawn from consideration: *31-39*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See the enclosed response..
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: Note the attached Notice of References Cited (PTO-892)..

Response to Arguments

Applicant's arguments filed 05 September 2007 have been fully considered but they are not persuasive.

Applicant argues with respect to the 35 USC 102 rejections. Applicant's arguments appear to be on the grounds that:

1) Merely hindsight is used to construct the rejection out of Morita based on Applicant's disclosure.

2) No single example teaching the claimed invention is pointed out in Morita.

3) Morita didn't want to obtain and wasn't looking for Applicant's invention; Morita was looking for something else.

Applicant argues with respect to the 35 USC 103 rejections. Applicant's arguments appear to be on the grounds that:

4) Laney would not be combined with Matsumoto because Applicant's results of stretching Laney's monolayer material (see Applicant's comp. ex. 4 and 5) being failure.

5) Laney is limited to poly(ethylene terephthalate) polyester.

6) None of the polyesters mentioned by Laney that were evaluated for the open-cell voided absorbent layer could be could be produced as a monolayer film without tearing during manufacturing.

7) Applicant's interprets Matsumoto to require no permeability and require high tensile strength, which would be destroyed by Laney.

8) Only with inorganic loading above 60% by weight can absorptive films be obtained, which is not taught by Matsumoto's examples.

The Applicant's arguments are addressed as follows:

1) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

2) Morita is relied upon for all that it teaches rather than individual examples.

3 and 5) The arguments of counsel cannot take the place of evidence in the record.

3) Moreover, the examiner recognizes that all of the claimed effects and physical properties are not positively stated by the reference(s). Note however that the references teach all of the claimed ingredients, process steps and process conditions and thus, the claimed effects and physical properties would necessarily be achieved by carrying out the disclosed process. If it is applicants' position that this would not be the case: (1) evidence would need to be presented to support applicants' position; and (2) it would be the examiner's position that the application contains inadequate disclosure in that there is no teaching as to how to obtain the claimed properties and effects by carrying out only these steps.

4) As previously described in the Office Action mailed 05 June 2007:

- Reliance on Applicant's Specification to show an expectation of failure does not overcome the references' not teaching failure of the combination.
- Applicant's stretching appears to be on a different material than Matsumoto is relied upon for since Applicant's example uses amorphous polyester resin not disclosed to be a PLA polyester resin (see Specification, page 21, lines 6-10 and 19-22) and Matsumoto is relied upon for teaching PLA resin (see col. 1, lines 6-9).
- Laney's teaching of using a backing is indicated as being a reinforcement (see col. 3, lines 1-7) which is less critical than Applicant's interpretation of the backing being an absolute in Laney to avoid failure.

4) As previously described in the Advisory Action mailed 18 July 2006:

- Matsumoto is the closest prior art and relied upon to show manufacturing a monolayer film. Laney is not relied upon to illustrate monolayer manufacturing.
- Comparative examples 4 and 5 use "PETG", which is significantly different from PLA used by Matsumoto. The Table indicates PLA, such as Matsumoto, as being successful.

5) As previously described in the Advisory Action mailed 18 July 2006, Laney teaches polyester, as does Matsumoto. They are viewed as both teaching polyesters. Moreover, it is well known to use PLA as taught by Matsumoto.

6) The examples relied upon (see Applicant's comp. ex. 4 and 5) to evaluate Laney are not commensurate in scope with the claims given the claims encompass

more than 42% void initiating particles and 69% is outside the claimed range and claims encompass more than barium sulfate and PMMA as void initiating particles.

7) As previously described in the Office Action mailed 05 June 2007:

- The Examiner interprets Matsumoto's teaching of increasing strength to be an indication of how to increase any PLA film product—by stretching it (see col. 1, lines 20-23)—rather than excluding films above the strength provided by Matsumoto's examples.
- Moreover, although the voids may not be relied upon for strength given their absence of material, the arguments of counsel regarding the strength of the voided material cannot take the place of evidence in the record.

8) Matsumoto is relied upon for all that it teaches rather than individual examples.

8) Moreover, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., inorganic loading above 60% by weight) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. As amended, absorbant is amended to absorbent. Mish (*Merriam-Webster's Collegiate Dictionary*, page 5, absorbent) equates the terms synonymously.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is (571) 272-8517. The examiner can normally be reached on Mon.-Thu. 7:30 a.m.-5 p.m. and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PB

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